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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/707,730	11/06/2000	Craig Hill	16778-704	8812
24353	7590	06/28/2004	EXAMINER	
BOZICEVIC, FIELD & FRANCIS LLP 200 MIDDLEFIELD RD SUITE 200 MENLO PARK, CA 94025			LANDSMAN, ROBERT S	
			ART UNIT	PAPER NUMBER
			1647	

DATE MAILED: 06/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/707,730	HILL ET AL.	
	Examiner	Art Unit	
	Robert Landsman	1647	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 25-46 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/20/04 + 8/7/03</u> | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Formal Matters

- A. The Amendment dated 4/20/04, has been entered into the record.
- B. Claims 25-46 are pending and are the subject of this Office Action.
- C. All Statutes under 35 USC not found in this Office Action can be found, cited in full, in a previous Office Action.

2. Information Disclosure Statement

- A. The Information Disclosure Statement dated 4/20/04 has been entered into the record.
- B. As stated in the Office Action mailed 10/21/03, the IDS dated 5/22/03 could not be found. All that was found was a statement over the attorney's signature regarding 37 CFR 1.56, but there was no page for the Examiner to initial which contained any cited references.
- C. The eIDS filed 8/7/03 has been located and a copy of the main page has been initialed and sent with this Office Action.

3. Claim Rejections - 35 USC § 112, first paragraph – scope of enablement

- A. The rejection of all claims under 35 USC 112, first paragraph, has been withdrawn in view of Applicants amendments to the claims to limit the scope to specific NGF-conjugated steroids.

4. Claim Objections

- A. Claims 25-46 are objected to since it is believed that the term "conjugate" is the correct term instead of "conjugant."
- B. Claims 25-46 are objected to since, at least in claim 25, the phrase "which conjugate group..." should be replaced with, for example "and wherein said conjugate group" for improved syntax.
- C. Claims 28-46 are objected to since the syntax could be improved by amending the claims to recite "through an epsilon amino group of a lysine residue."
- D. Claims 32 and 33 are objected to since it appears that they should depend from claim 31, which provides a Markush Group of these specific steroids.

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- E. Claim 35 is objected to since the term "NGF" is repeated twice.
- F. Claim 36 is objected to since it should likely depend from claim 28 since as written the claim recites both NGF as well as a fragment of NGF.
- G. Claim 36 is also objected to since the syntax could be improved by replacing the phrase "capable of binding" with "which binds."
- H. Claims 39 and 40 are objected to since it appears that they should depend from claim 33, which provides a Markush Group of these specific steroids.
- I. Claims 41 and 42 are objected to since it appears that they should depend from claim 31, which provides a Markush Group of these specific steroids.
- J. Claim 43 is objected to since it appears that it should depend from claim 41, which provides a Markush Group of the specific steroid.
- K. Claim 44 is objected to since it appears that it should depend from claim 42, which provides a Markush Group of the specific steroid.
- L. Claim 45 is objected to since it appears that it should depend from claim 31, which provides a Markush Group of the specific steroid.
- M. Claim 46 is objected to since it appears that it should depend from claim 45, which provides a Markush Group of the specific steroid.

4. Claim Rejections - 35 USC § 112, second paragraph

- A. Claim 31 recites the limitation "cortisone." Since no structure of cortisone could be found in the specification, it is unclear if cortisone meets the structural requirements recited in claim 25. There is insufficient antecedent basis for this limitation in the claim.

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5. Conclusion

A. No claim is allowable.

Advisory information

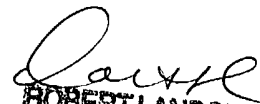
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Landsman whose telephone number is (571) 272-0888. The examiner can normally be reached on Monday - Friday from 8:00 AM to 5:00 PM (Eastern time) and alternate Fridays from 8:00 AM to 5:00 PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Gary Kunz, can be reached on (571) 272-0887.

Official papers filed by fax should be directed to (703) 872-9306. Fax draft or informal communications with the examiner should be directed to (571) 273-0888.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-0700.

Robert Landsman, Ph.D.
Patent Examiner
Group 1600
June 15, 2004


ROBERT LANDSMAN
PATENT EXAMINER